

## **REMARKS**

### **A. Status of the Claims**

Claims 13-47 were pending at the time of the Action. Claim 13 has been amended to correct a typographical error and to incorporate the subject matter of claim 24. Claim 24 has been canceled. Claims 39 and 46 have been amended to incorporate the subject matter of claim 43, and claim 43 has been canceled. Claim 31 also has been canceled. Thus, claims 13-23, 25-30, 32-42, and 44-47 are now pending.

### **B. Amendment to the Specification**

The Action indicated that the specification should contain a section entitled “Brief Description of the Drawings.” Applicant, therefore, has amended the specification to insert such a heading between the fourth and fifth paragraphs on page 8. The fifth paragraph already contains a brief description of the drawings.

### **C. The Claims Are Patentable Over Kobayashi, Schmidt, Takashi, Asahi Chem, and Chen**

The Action rejects claims 13-16, 19-23, 26, 30, and 32-47 under 35 U.S.C. § 103(a) as being obvious over Kobayashi (JP 58051880) in view of Schmidt (GB 1520738), Takashi (JP 0329701), Asahi Chem. (XP 002255668), and Chen (U.S. 3,342,719). The Action states that claims 17, 18, and 24-25 are allowable over the cited art. Thus, to advance the prosecution of this case, Applicant has incorporated the limitations of claim 24 into claim 13 and amended claim 25 to depend from claim 13. Accordingly, the rejection against claims 13-16, 19-23, 26, 30, and 32-38 is overcome.

With regard to claims 39-45, the Action states that these are product-by-process claims. The Action also appears to assert that claims 46-47 are product-by-process claims. In examining product-by-process claims, the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims (MPEP § 2113). Furthermore, only once

a product appearing to be *substantially identical* to the claimed product is found and a rejection under 35 U.S.C. § 103 is made does the burden shift to the applicant to show a unobvious difference (MPEP § 2113). The present rejection against claims 39-47 fails to establish a *prima facie* case of obviousness because the Action fails to identify a substantially identical product and thus shift the burden to Applicant, and also fails to consider the structure of the potato juice product implied by the process steps.

The Action identifies the juice product disclosed by Asahi Chem as the product that is allegedly the same as the claimed potato juice product. Asahi Chem, however, is concerned with fruit juice and not potato juice. A fruit juice is not “substantially identical” to a potato juice, even after these juices are filtered and electrodialized. Applicant further notes that Kobayashi is also concerned with fruit juices and, therefore, does not disclose a product that is substantially similar to the claimed product. Takashi is concerned with producing potato starch, which is a portion of the potato juice that is removed according to the methods of the presently claimed invention. Thus, Takashi also does not disclose a product that is substantially identical to the claimed product. Schmidt is concerned with the production of protein from potato corm water. Protein, however, is a portion of the potato juice that is removed according to the methods of the presently claimed invention. Thus, Schmidt also does not disclose a product that is substantially identical to the claimed product. Chen does not appear to disclose any products made from potato juice. Accordingly, the Action fails to identify a substantially similar product and thus fails to shift the burden to Applicant to show a unobvious difference (MPEP § 2113).

Applicants further note that the method steps recited in claims 39 and 46 result in a potato juice product containing the electrolyte portion of potato juice while separating out the main components of the potato, namely the carbohydrates, starch, proteins, and free amino acids (Specification, sentence bridging pages 2-3). Moreover, the method steps recited in claims 39

and 46 also change the quotient of acid-forming and base-forming electrolytes as compared to non-processed potato juice (*see e.g.*, Specification, p. 33, last two paragraphs). These are structural features of the potato juice product implied by the process steps, and must be considered when assessing the patentability of claims 39-47. The present Action, however, failed to consider these features.

In view of the above, the current claims are patentable over the cited art. Applicant, therefore, respectfully requests the withdrawal of this rejection.

**D. The Rejection Under 35 U.S.C. § 112, Second Paragraph, is Overcome**

Claim 31 was rejected as indefinite. Claim 31 has been canceled, thus rendering this rejection moot.

**E. Conclusion**

Applicants believe this paper to be a full and complete response to the Office Action dated July 31, 2007. Applicants respectfully request favorable consideration of this case in view of the above comments and amendments. Should the Examiner have any questions, comments, or suggestions relating to this case, the Examiner is invited to contact the undersigned Applicants' representative at (512)536-5654.

Respectfully submitted,



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